



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0844-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David W. CANNELL *et al.*

Application No.: 09/820,858

Filed: March 30, 2001

For: HEAT ACTIVATED DURABLE
CONDITIONING COMPOSITIONS
COMPRISING AN AMINATED C₃
TO C₅ SACCHARIDE UNIT AND
METHODS FOR USING THE
SAME

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) Group Art Unit: 1615
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) Examiner: B. Fubara
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) Confirmation No. 3869
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MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In reply to the Office Action mailed July 5, 2005, and pursuant to the July 12, 2005 OG Notice regarding the Pre-Appeal Brief Conference Pilot Program, Applicants respectfully request panel review of the twice-rejected claims. No amendments are being filed with this Request. A Notice of Appeal accompanies this Request, which is due October 5, 2005, and is timely filed.

REMARKS

Claims 1-30, 32, and 34-150 are pending. Claims 31, 33, 151, and 152 were canceled previously. Claims 10-12, 21-23, 27, 28, 30, 32, 34, 36, and 49-150 are withdrawn. Claims 1-9, 13-20, 24-26, 29, 35, and 37-48 are under consideration.

I. New Matter Rejection Under 35 U.S.C. § 112, ¶1

In the July 5, 2005, Office Action, the Office newly rejects claims 1-9, 13-20, 24-26, 29, 35 and 37-48 under 35 U.S.C. § 112, ¶1, as allegedly failing to comply with the written description requirement. Office Action, page 2. According to the Office "[t]he recitation that the amino groups of the polysaccharides are unsubstituted is new matter since the specification as originally filed requires that at least one amino group be unsubstituted. Applicants have not pointed to the specification upon which support for the new matter derives support." *Id.* Applicants' respectfully traverse this rejection.

In rejecting claims for an alleged lack of written description, the Office must set forth a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. M.P.E.P. § 2163.04. Express findings of fact are required. *Id.* Here, the Office has provided no support for its position. In fact, the Office's statement of the rejection itself appears to provide support for the recitation that the amino groups are unsubstituted. The Office also does not provide any reasons why the written support pointed to by Applicants in the October 4, 2004, amendment is inadequate. In the Status of the Claims section of the amendment filed October 4, 2004, Applicants noted that the "amendments and

response reflect the substance of the [September 13, 2004] interview” and that at that interview Applicants’ representative “had explained why the proviso of claim 1 over comes the rejection [of the claims as allegedly anticipated by Gruber].” October 4, 2004, Amendment, page 29. In their discussion of that rejection, Applicants noted that:

Applicants have amended claim 1 to recite “if the at least one compound comprising at least one C₅ to C₇ saccharide unit is chosen from polysaccharides, then the amino groups are unsubstituted.” Support for this amendment can be found in the specification at p. 17, line 4-5, which states that the amino groups can be chosen from unsubstituted groups.

Id. at 30.

Applicants respectfully submit that they have pointed to adequate support for the claim amendment in the specification. The specification at page 17, lines 4-5 states that “[a]ccording to the present invention, the at least one amino group may be chosen from substituted and unsubstituted amino groups.” This statement occurs in the discussion of the nature of the at least one C₅ to C₇ saccharide unit on pages 16-18 of the specification. Although Applicants respectfully submit that one of skill in the art would recognize that a polysaccharide is a compound comprising at least one C₅ to C₇ saccharide unit, the specification explicitly states in this same section that:

Non-limiting examples of the at least one compound include . . . polymers comprising at least one C₅ monosaccharide substituted with at least one amino group, polymers comprising at least one C₆ monosaccharide substituted with at least one amino group, polymers comprising at least one C₇ monosaccharide substituted with at least one amino group, and glycoproteins comprising at least one C₅ to C₇ saccharide unit substituted with at least one amino group.

Specification, page 17, lines 13-21. Polymers are explicitly defined in the specification to include polysaccharides. Specification, page 7, lines 16-18.

The specification, therefore, describes not only polysaccharides, but polysaccharides in which the amino groups are either substituted or unsubstituted. Having described both groups of polysaccharides, Applicants can choose to exclude from the claim scope polysaccharides in which the amino groups are substituted. See M.P.E.P. §§ 2163.05-2163.06 and *In re Johnson*, 558 F.2d 1008 (CCPA 1977). Accordingly, Applicants respectfully submit that the rejection of record is improper and request that the Office withdraw it.

II. Conditional Claim Rejections Under 35 U.S.C. §§ 102 and 103(a)

The Office further indicates that upon removal of the alleged new matter, the art rejections of record will apply. Office Action, page 2. Because Applicants submit that the new matter rejection under 35 U.S.C. § 112, ¶1 is in error, they have not amended claim 1. It is therefore their understanding that neither the conditional rejection of claims 1-9, 16, 17, 19, 20, 24-26, 29, 35, 45, 46, and 47 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,597,811 ("Gruber"), Office Action page 3, nor the conditional rejection of claims 1-9, 13-20, 24-26, 29, and 37-48 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Publication No. 2002/0102228 in view of Gruber, and further in view of U.S. Patent No. 5,332,581, *id.* at page 4, applies. Should the Office disagree, Applicants reiterate and incorporate their position, set forth in full in the paper filed May 18, 2005, that Gruber neither teaches nor suggests the claimed invention.

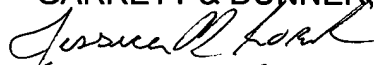
Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: October 5, 2005

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